

REMARKS

At the outset, Applicants point out that in response to Applicants' Request for Reconsideration, filed December 11, 2001, the Office mailed an Advisory Action dated December 26, 2001. However, the Advisory Action was not received at the Applicants' correspondence address mailroom until January 23, 2002. A copy of the date-stamped Advisory Action cover sheet is attached herewith. If the mail had been delivered in the normal timely manner, Applicants would have received the Advisory Action before the January 11, 2002, extension deadline, and would have been able to file this Amendment and Request for Continuing Examination. This unforeseen delay in receiving the mail was not the fault of the Applicants, and has required the Applicant to take a second month's extension of time to continue prosecution. Applicants reserve the right to petition the Commissioner to not have this second month of extension subtracted from any potential term extensions that may be applicable to any patent that may issue from this application.

I. Status of the Claims

Claims 22-58 are pending in this application. Applicants respectfully request consideration of the new arguments or new evidence and reexamination of the application, and timely allowance of the pending claims.

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II. Provisional Obvious Double Patenting

The Office has maintained its provisional rejection of claims 22-58 under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claims 29-61 of co-pending Application No. 09/600,136. (Office Action dated April 11, 2001, page 2.) Applicants respectfully request that these rejections be held in abeyance until all other grounds of rejection are removed, and then pass this case to issue pursuant to M.P.E.P. § 804(I)(B). The Examiner is invited to contact the undersigned so that appropriate measures can be taken to overcome this rejection to pass this case to allowance.

III. Rejections Under 35 U.S.C. § 103

A. *Aaslyng*

The Office maintains its rejection of claims 22-24 and 27-31 under 35 U.S.C. § 103(a) as being unpatentable over WO 97/19998 ("*Aaslyng*") for the reasons of record and as asserted at page 3 of the Office Action. Applicants respectfully traverse this rejection for the reasons of record and as supplemented with the following new arguments or new evidence, in accordance with the requirements of 37 C.F.R. § 1.114.

The Office admits that *Aaslyng* is deficient because "*Aaslyng* does not teach 3-methyl-4-aminophenol, heterocyclic couplers etc." (Office Action dated April 11, 2001, page 3.) The Office argues

a person of ordinary skill in the art would be motivated to use the prior art of *Aaslyng* to **substitut p-aminoph nol with 3-methyl-4 amino phenol** because they [are] **thought to b functionally equivalent by *Aaslyng***. Such modification would be obvious because one would expect that use of

3-methyl-4-aminophenol is **similarly useful and applicable in hair dyeing** compositions.

(Office Action, page 3, emphasis added.) As a basis for its assertion, the Office states that the **"patentee teaches them as equivalent coupler[s] listed on page 10 and line 2 in examples** to formulate a composition for dyeing hair." (Office Action dated April 11, 2001, page 3-4, emphasis added.) Applicants respectfully submit that **Aaaslyng provides no such teaching or suggestion**. Accordingly, this argument lacks the required motivation and expectation of success and fails to meet the Office's burden of establishing a *prima facie* case of obviousness.

The Federal Circuit requires a showing of a suggestion or motivation to modify the teachings of prior art references. See, e.g., *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). Modifying prior art references without evidence of such a suggestion or motivation simply takes the inventor's specification as a blueprint for piecing together the prior art to defeat patentability, *i.e.*, the essence of hindsight. *Dembiczak*, 50 USPQ.2d at 1617. This is why the Federal Circuit placed the burden on the Office to present "clear and **particular**" evidence showing motivation to combine or modify. *Id.* at 1617.

Futhermore, the Federal Circuit has also held that

This factual question of motivation is material to patentability, and could not be resolved on **subjective belief and unknown authority**. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.' ... Thus the [Office] must not only assure that the requisite findings are made, based on evidence of record, but must also **xplain the r asoning** by which the findings are deemed to support the agency's conclusion.

In re Sang Su Lee, Slip Opinion 00-1158, pages 6-7, citations omitted, emphasis added (Fed. Cir. January 18, 2002) (a convenience copy is attached.)

In this application, *Aaslyng* does not teach or suggest that 3-methyl-4-aminophenol is “functionally equivalent” or “similarly useful in hair dyeing” to p-aminophenol, as is alleged by the Office. One of ordinary skill in the art reading *Aaslyng*, including the Office’s citation of examples at page 10, line 2, would not be motivated to substitute p-aminophenol with 3-methyl-4-aminophenol. Indeed, the Office has admitted that *Aaslyng* fails to teach 3-methyl-4-aminophenol anywhere in the cited reference.

Applicants submit that the evidence relied upon by the Office for showing motivation to modify *Aaslyng* to substitute p-aminophenol with 3-methyl-4-aminophenol is apparently based only on subjective belief or unknown authority. As in *Sang Su Lee*, beyond the conclusory statements of record, the Office in the present application fails to explain the reasoning supporting its conclusion that one of ordinary skill in the art would be motivated to modify *Aaslyng*’s substitute p-aminophenol with 3-methyl-4-aminophenol to devise the specific present claimed composition comprising 3-methyl-4-aminophenol and an enzyme of laccase type. The Office has failed to present “clear and **particular**” **evidence** showing motivation to combine or modify as is required in *Dembiczak*, nor provided a **reasoned explanation** as required in *Sang Su Lee*. Thus, the evidence relied upon by the Office does not provide the requisite motivation for one of ordinary skill in the art to devise the Office’s proposed modification of *Aaslyng*.

Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection.

B. Aaslyng in view of Audousset

The Office maintains its rejection of claims 22, 25-26, 32-58 under 35 U.S.C. § 103(a) as obvious over *Aaslyng* in view of *Audosset et al.* U.S. Patent No. 5,769,903 ("*Audosset*") for the reasons of record, and as supplemented at pages 4-5 of the September 11, 2001, Office Action. Applicants respectfully traverse this rejection for the reasons that follow.

As discussed above, *Aaslyng* fails to teach or suggest Applicants' claimed combination recited in claim 22. While the Office has applied *Audosset* to cure the deficiencies of *Aaslyng*, *Audosset* also fails to provide the missing motivation requisite for a *prima facie* case of obviousness.

As a basis for maintaining the rejection, the Office asserted that "it is *prima facie* obvious to combine two compositions each taught by the *Aaslyng* and the *Audosset* [references] to be useful for the hair dyeing, in order to form a third composition which is to be used for the very same keratin hair dyeing purpose." (Office Action, page 4, citing *In re Kerkhoven*, 205 U.S.P.Q. 1069, 1072 (C.C.P.A. 1980)). Applicants respectfully disagree with the Office's reliance on *Kerkhoven* and traverse the rejection, for at least the reasons of record and as follows.

Audosset is directed to a composition for the oxidation dyeing of keratin fibers, comprising at least one oxidation base, at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. (*Audosset*, column 2, line 8 to column 3, line 58.) Contrary to the Office's apparent assertion at the last two lines of

page 5, *Audousset* teaches nothing at all about the enzymes of the laccase type recited in claim 22.

Applicants disagree with the Office's reliance on *Kerkhoven*, introduced in this case by the present Examiner only in the Final Office Action dated September 11, 2001, as a short cut means to establishing a *prima facie* case of obviousness without first establishing the elements of a *prima facie* case as required by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Further, as discussed below, Applicants submit that *Kerkhoven* has been improperly relied upon, and does not support the Office's position.

First, the facts and holding of *Kerkhoven* involved "combin[ing] two compositions each of which is taught by the prior art to be useful for the same purpose." *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980) (emphasis added). However, in contrast to *Kerkhoven*, in the present case the Office does not appear to be combining compositions. Rather, in an effort to reproduce Applicants' claimed invention, the Office is picking and choosing individual components from isolated disclosures in the cited references. However, "[s]uch piecemeal reconstruction of the prior art patents in light of [Applicant's] disclosure is contrary to the requirements of 35 U.S.C. 103." *In re Wesslan*, 147 USPQ 391, 393 (CCPA 1965). base, at least one indole coupler, and at least one heterocyclic coupler.

Moreover, Applicants submit that the Office has no evidence from which it can predict the outcome of the combination suggested by the Office, or have a reasonable expectation of success for the combination. In fact, it is known that dye components can

interact to affect the properties of the composition unpredictably, including its toxicity.

For example, in C. Zviak, *The Science of Hair Care*, Marcel Kekker, Inc., p. 329 (1986), Zviak explains that, with respect to the safety of finished products, “[a]ll finished cosmetic products must be evaluated for safety in use to make sure that they do not, under normal and foreseeable conditions, constitute a potential hazard for the consumer....” Zviak explains that such testing is not easily accomplished due to unpredictable component interactions. Specifically, “[i]t might seem that a sensible way of proceeding would be to conduct most toxicological tests on the ingredients, which would reduce the amount of experimentation and cost of developing finished products. However, experience has shown that the formulation itself is the important element. It determines local tolerance after a single or repeated application, eye and/ or lung mucosa tolerance, the degree of absorption through the skin, etc.” *Id.* Further, according to Zviak, synergistic effects that make a product more or less toxic may occur. That is, “[a]part from the effect of the vehicle, it has been observed that the association of different compounds can product either synergistic toxicity or, on the contrary, a mitigation or even inhibition of toxic effects.” *Id.*

The Office’s conclusory statements are not adequate grounds for a rejection based on obviousness. “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998). Furthermore, as a basis for asserting adequate motivation, the Office apparently relies only upon subjective belief or unknown authority for asserting what

properties one of ordinary skill in the art would expect from the composition when combining components that may have been used separately in the art at one time. "This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Sang Su Lee*, Slip Opinion 00-1158, page 6. Indeed, the Examiner can satisfy the burden of showing obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992).

In this case, the Office has not provided an adequate explanation of why it would have been allegedly obvious to combine the teachings of *Aaslyng* and *Audousset*. Here, *Aaslyng* fails to provide the requisite motivation necessary to support a prima facie case of obviousness because it does not teach or suggest choosing one individual component, a laccase type enzyme, from *Aaslyng*'s multicomponent composition and combining it with second individual component, 3-methyl-4-aminophenol, taught in *Audousset*'s different multicomponent composition. The Office is impermissibly picking and choosing individual components from different teachings without providing clear and particular evidence or a reasoned explanation of why one of ordinary skill in the art would have devised these very specific modifications. Motivation to devise the present claimed compositions can be found only in the Applicants' specification. Other than improper hindsight, there is no reason to combine the two references. Although directed toward claim 22, these remarks apply with equal force to all of the other claims.

Accordingly, because *Audousset* and *Aaslyng* fail to teach or suggest every element of the Applicant's invention as now claimed, the Office has not established a *prima facie* case of obviousness. Therefore, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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